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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,144	07/09/1999	KAZUNORI TAKAHASHI	21.1935	7639
21171	7590	10/22/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CHEVALIER, ROBERT	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/350,144

Applicant(s)

TAKAHASHI, KAZUNORI

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,10-18 and 22-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-6,13,15-18,25,27-29,31,32,37,38,40,41,46,47 and 49 is/are allowed.
- 6) ☒ Claim(s) 2,10-12,14,22-24,26,30,33-36,39,42-45 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Arguments***

1. Applicant's arguments with respect to claims 10-11, 14, 22, 30, 33-36, 39, 42-45, and 48, have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2, 11-12, 14, 24, and 26, are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto et al (P.N. 5,627,655).

Okamoto et al discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 2, 14, and 26, including the feature of the storage device recording screen information of picture information (See Okamoto et al's Figure 1, components 1, and 14), the feature of detecting a copy guard signal indicating a copying prohibition included in an input video signal of picture information (See Okamoto et al's Figure 1, components 7, 4, and 2, and column 3, lines 22-25, where Okamoto et al discloses inhibition of recording operation in the case of detecting from the inputted video signal copy guard or information indicating copying prohibition or inhibition operation), the feature of digitizing the input video signal (See Okamoto et al's Figure 1, component 6), the feature of the processing circuit preventing from storing digitized screen information to the storage device in a case where the copy guard detecting circuit detects the copy guard signal (See the processing circuit shown in

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Okamoto et al's Figure 1, components 2-3, and further, see Okamoto et al's column 3, lines 22-25, where Okamoto et al discloses inhibition of recording operation in the case of detecting from the inputted video signal copy guard or information indicating copying prohibition or inhibition operation), and the feature of the picture information input from the first device being stored at the storage device in order to record and the stored picture information being outputted in order to reproduce as specified in the present claims 2, 14, and 26. (See the capability of recording and reproducing the inputted video signal to and from the storage means when copy inhibition signal is not detected from the inputted video signal as shown in Okamoto et al's Figure 1, components 1, 14, and 2).

With regard to claim 11, it is noted that all of the features recited thereof are present in the Okamoto et al, including the feature of the storage device wherein screen information of picture information and picture information stored at the storage device is outputted to reproduce (See the capability of reproducing video information recorded at the storage means as shown in Okamoto et al's Figure 1, components 1, 14, and 2), the feature of controlling screen information recorded at the storage device (See Okamoto et al's Figure 1, component 4), the feature of encoding and outputting the screen information of the video signal (See the capability of encoding the inputted video signal and outputting the same to the storage means for recording purposes, as shown in Okamoto et al's Figure 1, components 3-2 for the encoding means, and Okamoto et al's Figure 1, components 1, 14, and 2 for the recording means wherein the outputted encoded signal is recorded), and the feature of preventing the video encoding circuit

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from outputting the video signal, in a case where the screen information is protected from copying as specified in the present claim 11. (See the processing circuit shown in Okamoto et al's Figure 1, components 2-3, and further, see Okamoto et al's column 3, lines 22-25, where Okamoto et al discloses inhibition of recording operation in the case of detecting from the inputted video signal copy guard or information indicating copying prohibition or inhibition operation).

With regard to claims 12, and 24, it is noted that all of the features recited thereof are present in the Okamoto et al, including the feature of the storage device wherein screen information of picture information and picture information stored at the storage device is outputted to reproduce (See the capability of reproducing video information recorded at the storage means as shown in Okamoto et al's Figure 1, components 1, 14, and 2), the feature of controlling screen information recorded at the storage device (See Okamoto et al's Figure 1, component 4), the feature of the encoding circuit adding a copy guard signal indicating a copy prohibition in the case where the screen information is protected from copying, encoding the screen information and outputting the video signal as specified thereof. (See the capability of adding copy prohibition to the video signal during reproduction operation in the case wherein copy is inhibited, or not at all permitted as indicated in Okamoto et al's column 4, lines 11-14; and for the encoding circuit of the present claimed invention, attention is directed to Okamoto et al's Figure 1, components 3, and 5, or components 8, and 9).

4. Claims 10, 22-23, 33, and 42, are rejected under 35 U.S.C. 102(b) as being anticipated by the submitted prior art of Kitazawa Hiroaki (P.N. 09083920).

The submitted prior art Kitazawa discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 10, and 22, including the feature of recording digitized screen information and outputting the video signal of the screen information (See the capability of recording/reproducing the inputted and digitized video signal when copyright protection is not detected on and from the recording means 208 as shown in Kitazawa's Figures 1 and 2, components 204, 208), the feature of reducing the digitized screen information to deteriorate the quality of an image, in a case where the digitized screen information is protected from copying as specified thereof is present in the submitted prior art of Kitazawa. (See the capability of masking the video data or introducing noise to the video data before recording the same on the recording medium when the copyright protection signal is detected as shown in Kitazawa's page 7).

With regard to claim 23, it is noted that all the features recited thereof are present in Kitazawa, including the feature of recording and outputting picture information stored at a storage device to reproduce (See the capability of recording and reproducing inputting and digitized video data when the copyright information is not detected to and from the recording means as shown in Kitazawa's Figure 1, components 204, and 208, and see the first paragraph of page of the submitted prior art of Kitazawa), and the feature of preventing outputting of a video signal in the case where the screen information is protected from copying as specified in the present in claim 23. (See the capability of masking the video data or introducing noise to the video data provided for

recording and the incapability of reproducing the original video data when the copyright protection signal is detected as shown in Kitazawa's page 7).

With regard to claims 33, and 42, the feature of the screen information being reduced by at least one of pixel reduction, line reduction and frame reduction as specified thereof would be inherently present in the cited reference of Kitazawa. Since, the cited reference of Kitazawa would have already included the capability of reducing, or deteriorating the quality of the inputted video data. (See the capability of masking the video data or introducing noise to the video data before recording the same on the recording medium when the copyright protection signal is detected as shown in Kitazawa's page 7).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30, 35-36, 39, 45, and 48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al in view of the admitted prior art, Figure 2, and described at pages 3-4, of the present Application.

Okamoto et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 30, 35-36, 39, 45, and 48, including the feature of digitizing input video signal and storing recording screen information of

picture information to a storage device and the feature of preventing from storing digitized screen information to the storage means in the case where copy guard signal is detected as specified in the present claims 30, 35-36, 39, 45 and 48. (See the above rejection of claim 2).

Okamoto et al fails to specifically disclose the feature of the inputted information displayable on a screen of a display device without a deterioration of image quality both when the image processing circuit is prevented, and not prevented, from storing screen information as specified in the present claims 30, 35-36, 39, 45, and 48.

The admitted prior art, Figure 2, described at pages 3-4, of the present Application discloses a video recording/reproducing apparatus that includes the capability of displaying inputted video data without deterioration on a screen of a display device regardless of whether copy guard signal is detected or not as claimed in claims 30, 35-36, 39, 45, and 48.

It would have been obvious to one skilled in the art to modify the Okamoto et al's recording/reproducing apparatus wherein the inputting means provided thereof (See Okamoto et al's Figure 1, components 10, and 12) would have a display means connected thereof for the purpose of displaying inputted video data without deterioration on a screen of a display device regardless of whether copy guard signal is detected or not in the same conventional manner as is described in the admitted prior art described at Figure 2 of the present Application. The motivation being to be able to view the inputted video data on a display means at any desired time as suggested in the prior art.



7. Claims 34, and 43-44, are rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art of Kitazawa Hiroaki (P.N. 09083920) in view of the admitted prior art, Figure 2, and described at pages 3-4, of the present Application.

Kitazawa discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 34, and 43-44, including the feature of recording and outputting screen information of picture information to a storage device and the feature of reducing the screen information to deteriorate an image quality in the case where the screen information is protected from copying as specified in the present claims 34, and 43-44. (See the above rejection of claim 10).

Kitazawa fails to specifically disclose the feature of the inputted information displayable on a screen of a display device without a deterioration of image quality both when the image processing circuit is prevented, and not prevented, from storing screen information as specified in the present claims 34, and 43-44.

The admitted prior art, Figure 2, described at pages 3-4, of the present Application discloses a video recording/reproducing apparatus that includes the capability of displaying inputted video data without deterioration on a screen of a display device regardless of whether copy guard signal is detected or not as claimed in claims 34, and 43-44.

It would have been obvious to one skilled in the art to modify the Kitazawa's recording/reproducing apparatus wherein the inputting means provided thereof (See Kitazawa's Figure 1, component 1) would have a display means connected thereof for the purpose of displaying inputted video data without deterioration on a screen of a

display device regardless of whether copy guard signal is detected or not in the same conventional manner as is described in the admitted prior art described at Figure 2 of the present Application. The motivation being to be able to view the inputted video data on a display means at any desired time as suggested in the prior art. .

8. Claims 1, 3-6, 13, 15-18, 25, 27-29, 31-32, 37-38, 40-41, 46-47, and 49, contain allowable subject matter over the prior art of record.

### ***Response to Arguments***

9. Applicant's arguments filed 8/2/04 have been fully considered but they are not persuasive.

Regarding the Applicant's argument in that the cited reference of Okamoto et al fails to disclose the claimed feature of the copying prohibition, Examiner disagrees. It is noted that such a feature of copying prohibition recited in the present claimed invention is disclosed in Okamoto et al. (See Okamoto et al's Figure 1, components 7, 4, and 2, and column 3, lines 22-25, where Okamoto et al discloses inhibition of recording operation in the case of detecting from the inputted video signal copy guard or information indicating copying prohibition or inhibition operation).

Regarding the Applicant's argument in that the cited reference of Kitazawa Hiroaki fails to disclose the image processing apparatus recording screen information as claimed in claim 23, Examiner disagrees. It is noted that such a feature argued by Applicant is present in the cited reference of Kitazawa. (See the capability of recording and reproducing inputting and digitized video data when the copyright information is not

detected to and from the recording means as shown in Kitazawa's Figure 1, components 204, and 208, and see the first paragraph of page of the submitted prior art of Kitazawa).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Chao et al discloses a compression/decompression including the feature of reducing the quality of the inputted image data.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier  
October 14, 2004.

  
ROBERT CHEVALIER  
PRIMARY EXAMINER